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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/575,249

Applicant(s)

MYERS, CONNIE D.

Examiner

Jean D Janvier

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52, 57-68 and 73-82 is/are pending in the application.
- 4a) ~~Of the above claim(s) 53-56 and 69-72 is/are withdrawn from consideration.~~ **CANCELED**
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52, 57-68 and 73-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3622

### **Response To Applicant's Amendments**

The objection to the title of the invention and the 101 Rejection are still maintained (see below). Further, the objection and the 112(2) Rejection applied to the claimed invention have been withdrawn.

### **DETAILED ACTION**

#### ***Specification***

The title of the invention, under 37 CFR 1.72, should be descriptive, brief and technically accurate.

#### **Status of the claims**

Claims 1-44 were originally presented and claims 45-76 were added by a preliminary amendment. After the first Office Action on the merits, claims 53-56 and 69-72 were canceled and claims 77-82 were added. Claims 1-52, 57-68 and 73-82 are now pending in the Instant Application.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3622

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In*

Art Unit: 3622

*re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method

Art Unit: 3622

exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Claims 1-22, 78-79 and 45-60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Here, the steps as recited in the claims pertain to a manual process and therefore, the claims do not fall within the technological art. For example, although independent claims 1 and 45 recite, in the preambles of the claims, "... A method in a computer system for tracking and processing...", however the bodies of the claims do not refer to any device or hardware or the computer system used in the preambles. To this end, a relevant device or hardware, such as a computer system, a database, a data

Art Unit: 3622

communication, computer network, the Internet and so and so forth should be used to implement the steps or process recited in at least claims 1 and 45.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-52 and 57-68 and 73-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (hereinafter Barnett), US Patent 6, 321, 208 B1.

As per claim 1, Barnett discloses a system (advertising medium) for distributing over the Internet electronic coupons from distributor 16 and coupon issuer 14 (vendor) to a specific user using a personal computer 6 of fig. 1 linked to a server or a web server or online service provider 2 having a database 40 (storing multi-vendor-rebate-list or coupon data) containing product coupons and information on products and services (promotional items or advertisements) available for sales at participating retail stores or online shopping malls and wherein upon

Art Unit: 3622

connecting to said system or online service provider 2 of fig. 1 over the Internet, the user using personal computer 6 can download coupon data directly to his personal computer memory or Hard disk drive where they can be printed in the form of paper coupons 70 (hard copies-fig. 5). Subsequently, the user takes the printed coupons to a participating retail store and wherein upon detecting the presence of a UPC code related to a promotional item associated with a printed coupon in the customer's order, the coupon is redeemed accordingly, subsequent to verifying the identity of the user or the bearer of the coupon, and a price reduction is applied to the customer's order and the user's or customer's transaction data including the coupon redemption information are forwarded to the coupon distributor 16 and/or coupon issuer 14 where they can be used to further prepare targeted coupon packages for the user or customer. In a further embodiment, the user is conducting a business transaction with an online shopping mall (having a server or e-tail server), which is connected over the Internet to the online service provider 2 so as to detect (search) in the customer's order any matching UPC code associated with a discount coupon, stored in database 40 of online service provider 2, and if a matching UPC code is found, the value of the coupon is determined in real-time and a price reduction is automatically applied to the customer's order. In other words, the process of receiving coupon data (a portion of the multi-vendor-rebate list) from a coupon issuer 14 (vendor) and displaying the coupon data (multi-vendor-rebate list) to a user, who accesses the online service provider 2 to download coupon information are anticipated by the prior art.

(See abstract; figs. 1, 5; col. 8: 14-21; col. 11: 29-43; col. 12: 14-31).



As per claims 2-4, 5, 6, 7, 8, 10, 12-22, 47, 51, 57-60 and 77-82, Barnett discloses a system (advertising medium) for distributing over the Internet electronic coupons from distributor 16 and coupon issuer 14 (vendor) to a specific user using a personal computer 6 of fig. 1 linked to a server or a web server or online service provider 2 having a database 40 (storing multi-vendor-rebate-list or coupon data) containing product coupons and information on products and services (promotional items or advertisements) available for sales at participating retail stores or online shopping malls and wherein upon connecting to said system or online service provider 2 of fig. 1 over the Internet, the user using personal computer 6 can download coupon data directly to his personal computer memory or Hard disk drive where they can be printed in the form of paper coupons 70 (hard copies-fig. 5). Subsequently, the user takes the printed coupons to a participating retail store and wherein upon detecting the presence of a UPC code related to a promotional item associated with a printed coupon in the customer's order, the coupon is redeemed accordingly, subsequent to verifying the identity of the user or the bearer of the coupon, and a price reduction is applied to the customer's order and the user's or customer's transaction data including the coupon redemption information are forwarded to the coupon distributor 16 and/or coupon issuer 14 (vendor or manufacturer) where they can be used to further prepare targeted coupon packages for the user or customer and to reimburse the retailer 10 for honoring or redeeming the coupon during a transaction (transmitting data or transaction data and redemption information to inform a vendor or coupon issuer 14 or manufacturer that a coupon having a specific code 90 associated with a particular user has been redeemed). In a further embodiment, the user is conducting a business transaction with an online shopping mall (having a server or e-tail server), which is connected over the Internet to the online service

Art Unit: 3622

provider 2 so as to detect (search) in the customer's order any matching UPC code associated with a discount coupon, stored in database 40 of online service provider 2, and if a matching UPC code is found, the value of the coupon is determined in real-time and a price reduction is automatically applied to the customer's order. In other words, the process of receiving coupon data (a portion of the multi-vendor-rebate list) from a coupon issuer 14 (vendor) and displaying the coupon data (multi-vendor-rebate list) to a user, who accesses the online service provider 2 to download coupon information are anticipated by the prior art.

It is further to be understood that advertisers or vendors or manufacturers or coupon issuer 14 and distributor 16 should be able to receive, from the system or advertising medium, information related, for example, to the number of downloaded coupons, demographic profile of users downloading specific coupons, number of times a particular coupon was viewed by users, billing statement concerning the amount of money owed by a vendor, etc., subsequent to transmitting, by a valid or identified vendor or coupon issuer 14 or distributor 16, a request (inquiry) requesting such information from the advertising medium or provider 2, wherein part of this information is used to further prepare customized packages (coupons) in order to target specific users or customers.

(See abstract; figs. 1, 5; col. 7: 12-20; col. 7: 36-55; col. 8: 14-21; col. 11: 29-43; col. 12: 14-31).

As per claims 5, 6-7, 48-50 and 52, Barnett discloses a system (advertising medium) for distributing over the Internet electronic coupons from distributor 16 and coupon issuer 14 (vendor) to a specific user using a personal computer 6 of fig. 1 linked to a server or a web server

Art Unit: 3622

or online service provider 2 having a database 40 (multi-vendor-rebate-list) containing product coupons and information on products and services (promotional items or advertisements) available for sales at participating retail stores or online shopping malls and wherein upon connecting to said system or online service provider 2 of fig. 1 over the Internet, the user using personal computer 6 can download coupon data directly to his personal computer memory or Hard disk drive where they can be printed in the form of paper coupons 70 (hard copies-fig. 5). Subsequently, the user takes the printed coupons to a participating retail store and wherein upon detecting the presence of a UPC code related to a promotional item associated with a printed coupon in the customer's order, the coupon is redeemed accordingly, subsequent to verifying the identity of the user or the bearer of the coupon, and a price reduction is applied to the customer's order and the user's or customer's transaction data, including coupon value, expiration date, product associated with the coupon, the customer's identification, the retail store where the coupon was redeemed or the coupon redemption information, etc., are forwarded or transmitted to the coupon distributor 16 and/or coupon issuer 14 (vendor or manufacturer) where they can be used to further prepare targeted coupon packages for the user or customer and/or pay or compensate the retailer by crediting the retailer's account or electronically transfer funds to the retailer's bank account using conventional means. In a further embodiment, the user is conducting a business transaction with an online shopping mall (having a server), which is connected over the Internet to the online service provider 2 so as to detect (search) in the customer's order any matching UPC code associated with a discount coupon, stored in database 40 of online service provider 2, and if a matching UPC code is found, the value of the coupon is determined or in real-time (transmitting coupon data to inform a retailer of specific coupon or

Art Unit: 3622

rebate data associated with an identified customer) and a price reduction is automatically applied to the customer's order. In a further embodiment, the coupon data associated with an identified customer can be electronically transmitted to a local retail store where the customer can redeem the said coupon. In other words, the process of receiving coupon data (a portion of the multi-vendor-rebate list) from a coupon issuer 14 (vendor or manufacturer) and displaying the coupon data (multi-vendor-rebate list) to a user, who accesses the online service provider 2 to download coupon information are anticipated by the prior art (col. 11: 29-43).

It is further to be understood that owners (retailers 10) of retail stores redeeming coupons can receive from the system information related, for example, to the amount of money due to the retailers by coupon issuer 14 and distributor 16 for redeeming coupons presented by identified customers, subsequent to transmitting by the retailers redemption data, including coupon value, expiration date, product associated with the coupon, the customer's identification, the retail store where the coupon was redeemed, etc., to the system. In other words, billing statements and reports concerning the amount of money owed by a vendor or coupon issuer 14 (manufacturer) to the advertising medium or provider 2 for distributing the coupon issuer 14 coupons (advertisements) over the Internet can be generated, as a part of a routine conducted by the advertising medium on a periodic basis such as a monthly billing statement and/or report issued for each vendor or coupon issuer 14 showing or displaying the amount owed for services rendered. Finally, the redemption center 13 can also generate the billing statements and reports based on a schedule, upon receipt of transaction data including redeemed coupon data from retailers 10 of fig. 1, and transmit them to different parties involved in the coupon distribution and redemption system (clearing process), for payments and management purposes, wherein the

Art Unit: 3622

billing statements and/or reports show or display the amount of money that must be paid to the retailers 10 by the coupon issuers 14 or vendors (manufacturers) as practiced in the art.

(See abstract; figs. 1, 5; col. 7: 36-55; col. 8: 14-21; col. 11: 29-43; col. 12: 14-31).

As per claims 9 and 11, Barnett implicitly teaches adjusting a counter or decrementing a counter or updating an information database 40 regarding the number of coupons redeemed (volume-of-usage) by retail stores 10 subsequent to receiving redeemed coupon 18 data from the redemption center 13, wherein the redeemed coupon data are forwarded to the coupon issuer 14 (vendor or manufacturer) and used to further prepare more customized packages for the customers, reimburse different retailers 10 for redeeming or honoring coupons presented by customers and to measure the effectiveness of the coupon distribution system. Further, the redeemed coupon data (volume-of-usage) related, for example, to a particular coupon are used to update the database 40 by decrementing a coupon counter value from 1 to 0 (meaning that the one-time redemption of the particular coupon has indeed taken place), thereby preventing any additional redemption of the particular coupon while eliminating fraudulent activities. It is also expected that the system will update its database or central repository 40 subsequent to changing or modifying variable coupon data or deleting expired coupons previously downloaded by a user and stored in a local database of the user's computer 6 to thereby maintain accurate accounting and prevent fraudulent activities. Finally, usage data or redemption data (volume-usage data) can be used to update (decrement a counter) database 40 containing coupon data received from coupon issuers 14 and distributors 16 (vendors or manufacturers) and these usage or redemption data can be used not only to prevent subsequent or illegal redemptions by users and/or retailers

Art Unit: 3622

10 of already redeemed coupons, but also to modify or customize by the coupon issuers 14 and distributors 16 coupon packages specifically targeted to users, based at least in part on their usage history or redemption activities, and wherein the coupon issuers 14 transmit these coupon package data to the system provider 2 in order to update, modify or change the content of central repository or database 40 coupled to the system provider server and wherein the users can subsequently download these new coupon data (See abstract; col. 5: 22-61; col. 6: 52-65; col. 7: 35-55; col. 10: 47 to col. 11: 28; col. 11: 44 to col. 12: 13; col. 13: 24-33).

Claims 23-44 recite limitations already addressed in claims 1-22 respectively and therefore, these limitations of claims 23-44 are rejected under a similar rationale as respectively applied to claims 1-22.

As per claim 45, Barnett discloses a system (advertising medium) for distributing over the Internet electronic coupons from distributor 16 and coupon issuer 14 (vendor) to a specific user using a personal computer 6 of fig. 1 linked to a server or a web server or online service provider 2 having a database 40 (storing multi-vendor-rebate-list or coupon data) containing product coupons and information on products and services (promotional items or advertisements) available for sales at participating retail stores or online shopping malls and wherein upon connecting to said system or online service provider 2 of fig. 1 over the Internet, the user using personal computer 6 can download coupon data directly to his personal computer memory or Hard disk drive where they can be printed in the form of paper coupons 70 (hard copies-fig. 5). Subsequently, the user takes the printed coupons to a participating retail store and wherein upon

detecting the presence of a UPC code related to a promotional item associated with a printed coupon in the customer's order, the coupon is redeemed accordingly, subsequent to verifying the identity of the user or the bearer of the coupon, and a price reduction is applied to the customer's order and the user's or customer's transaction data including the coupon redemption information are forwarded to the coupon distributor 16 and/or coupon issuer 14 where they can be used to further prepare targeted coupon packages for the user or customer. In a further embodiment, the user is conducting a business transaction with an online shopping mall (having a server or e-tail server), which is connected over the Internet to the online service provider 2 so as to detect (search) in the customer's order any matching UPC code associated with a discount coupon, stored in database 40 of online service provider 2, and if a matching UPC code is found, the value of the coupon is determined in real-time and a price reduction is automatically applied to the customer's order. In other words, the process of receiving coupon data (a portion of the multi-vendor-rebate list) from a coupon issuer 14 (vendor) and displaying the coupon data (multi-vendor-rebate list) to a user, who accesses the online service provider 2 to download coupon information are anticipated by the prior art.

(See abstract; figs. 1, 5; col. 8: 14-21; col. 11: 29-43; col. 12: 14-31).

As per claim 46, it is inherent in the prior art (current reference) that each coupon issuer 14 and distributor 16 (vendor) is assigned an ID, account number or identifier or code used to identify the coupon issuer 14 (vendor or manufacturer) or distributor 16, who provides the coupon data. The coupon issuer 14 (vendor or manufacturer) or distributor 16 can also use the identifier, in the form of a password, code or ID or account number, to access the advertising

Art Unit: 3622

medium or provider 2 (as discussed above), as commonly practiced in the art. In other words, it is understood that distributor 16 or coupon issuer 14 can change or update the coupon data already stored in database 40 of the online service provider in real-time (otherwise this is an archive rather than a database as used in the art) upon accessing the online service provider web site using a password and a login ID or any other identifier (since only those with appropriate privileges or rights can access the online service provider system and update data stored in the database 40 as known in the art). An identified coupon issuer 14 can request, for example, that the online service provider 2 change or update coupon data, such as the coupon redemption values or amounts, of coupons already downloaded and stored on the user's computer 6 permanent memory (permitting the vendor or coupon issuer 14 or distributor 16 to electronically modify coupon or rebate data -col. 5: 35-46; col. 12: 7-13; col. 12: 51-62).

Claims 61-68 and 73-76 substantially recite limitations already addressed in claims 45-52 and 57-60 respectively and therefore, these limitations of claims 61-68 and 73-76 are rejected under a similar rationale as respectively applied to claims 45-52 and 57-60.

### **Response To Applicant's Arguments**

First and foremost, the Applicant's arguments related to amended claims and new claims are fully addressed in the above Office Action.

Second of all, and in general, Applicant argues on page 23, regarding the last Office Action, that Barnett is not all directed to, nor does Barnett describes, **any mechanism for a vendor to electronically obtain information**. The Examiner respectfully and completely



Art Unit: 3622

disagrees with the Applicant's findings as herein presented. Indeed, the vendor or coupon issuer receives or obtains information such as transaction data electronically from the coupon redemption center 13 associated with the online service provider 2 or distribution system, subsequent to redeeming the coupons by retailers 10, wherein the transaction data are used by the vendor or coupon issuer 14 for integration into marketing analysis to further prepare targeted coupon packages for the customers. Further, the online service provider 2 also stores in demographic data file 42 (database file), coupled to the coupon package database 40 of fig. 6, user-specific data including coupon selected data, coupon deleted data, coupons printed data and user demographics, which are subsequently transmitted electronically to a coupon distributor 16 (or coupon issuer 14 as has been alternatively used in the reference). (See abstract; col. 6: 52-65; figs. 1, 5; col. 7: 36-55; col. 8: 14-21; col. 11: 29-43; col. 12: 14-31).

Third of all, a great deal of the argued limitations is not present in the current claimed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)).

Fourth of all, Applicant further argues that the Examiner is engaging in impermissible or improper hindsight reconstruction in order to address some of the claim limitations using the Barnett's reference. Here, and in general, arguments associated with hindsight reconstruction language pertain to a 103 Rejection as opposed to a 102 Rejection since only a single reference was used in the prosecution or examination of the claimed invention. It appears rather that the Applicant disagrees with Examiner's interpretation of the applied reference vis-à-vis the claimed invention. For instance, the Applicant "requests" that the

Art Unit: 3622

Examiner point out where in the reference "it is inherent in the prior art (current reference) that each coupon issuer 14 and distributor 16 (vendor or manufacturer) is assigned an ID, account number or identifier or code used to identify the coupon issuer 14 or distributor 16, who provide the coupons" can be found. First, each coupon issuer 14 must be assigned an identifier so that each coupon issuer 14 can be uniquely identified to the system for management purpose or to simply identify which coupon issuer 14 has provided or transmitted the coupon data to the online service provider 2 (See abstract; col. 5: 22-33; col. 1: 52-65; col. 11: 11-23). The latter is inherent in any distribution system or network. Further, this identifier can be a code, an account number or password along with a logging name that allows a coupon issuer 14 to transmit coupon data to the online service provider 2 (See abstract; col. 5: 22-33; col. 1: 52-65; col. 11: 11-23).

Moreover, upon considering the Applicant's remarks, it appears that the applied reference is not being interpreted with the level of skill of a professional in the art (an ordinary artisan). The fact that the reference does not textually or explicitly disclose a specific teaching does not necessarily mean that the teaching is not silently or implicitly supported therein considering the knowledge or background of a skilled professional. In addition, features that are inherent in the art or widely used in the industry need not be disclosed in a reference in order for these features to be anticipated by the current prior art; in other words, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art does not preclude a finding of anticipation (MPEP 2131.01 (111)).

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the

Applicant's arguments as herein presented are not plausible and thus, the present Office Action **has been made Final.**

### **Conclusion**

The following references, although not used, are considered to be relevant-

WO 97/23838 to Scroggie discloses an incentive distribution network or system for providing purchase incentive offers, such as electronic coupons, recipes, rebates, shopping aids, product samples, supermarket specials, etc. to qualified customers over the Internet. First of all, the customer logs into the system and fills out a registration form where he provides his demographic information including geographical location having a specific zip code and other postal code since the features of the present system are location-dependent. If it is determined by the system that the submitted zip code is a valid zip code, that is a zip associated with a retail store where an electronic coupon can be redeemed, then the system allows the customer to proceed to the main menu and browse among available purchase incentive offers. The system merges customer supplied-information 270 with other purchase incentive data 272 of fig. 12 and creates a printable graphical image of the purchase incentive 282 for transmission or delivery to the identified customer. In one alternate embodiment of the invention, the purchase incentive or electronic coupon is not directly transmitted to the customer instead the terms of the purchase incentive or coupon, for example, are transmitted electronically to a retail store 310 of fig. 13, located in the customer's geographical location or zip code, pre-selected by the said customer, who receives either a token 316 or an advisory message to present at the retail store 310 during a

Art Unit: 3622

redemption process. In a further embodiment of the invention, incentives may be targeted to a specific customer based on the customer's purchase history (previous purchase) 502 and transmitted to consumer's computer 510 via electronic mail or e-mail address stored in a consumer database 506, storing customer's registration information, coupled to system's administrator's online web site 508 of fig. 15 having a web server or using a personal web page in the computer network established for each consenting consumer (See abstract; page 10: 4 to page 11: 14; figs. 1-5, 11-16).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally

Art Unit: 3622

be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

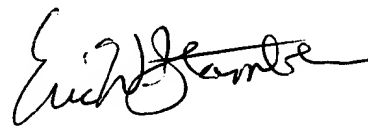
Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

11/28/03

  
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